



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/713,398

11/14/2003

Makoto Inaba

P/3541-48

9897

2352 7590 03/27/2008  
OSTROLENK FABER GERB & SOFFEN  
1180 AVENUE OF THE AMERICAS  
NEW YORK, NY 100368403

EXAMINER

HALL, DEANNA K

ART UNIT

PAPER NUMBER

3767

MAIL DATE

DELIVERY MODE

03/27/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/713,398	<b>Applicant(s)</b> INABA, MAKOTO	
	<b>Examiner</b> DEANNA K. HALL	<b>Art Unit</b> 3767	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 20 December 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>December 20, 2007</u> .                                       | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Acknowledgments***

1. This office action is in response to the reply filed on December 20, 2007.
2. In the reply, the applicant amended claims 1-2, 6-7 and 11; and added new claims 12-13. Claims 1-13 are pending in the application.
3. Examiner acknowledges receipt of the new compliant declaration filed on December 20, 2007.

### ***Information Disclosure Statement***

4. The information disclosure statement (IDS) submitted on December 20, 2007 is in compliance with the provisions of 37 CFR 1.97(b). Accordingly, the IDS is being considered by the Examiner.

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
6. **Claims 1-3, 6-8 and 12-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kalloo et al. (US 2001/0049497) ("Kalloo") in view of Valley et al. (US 6,251,093) ("Valley").**

Kaloo discloses: a first bendable catheter 40 with a bending control section which guides the tube [0028], [0032]; and a second catheter 10 attached to the first catheter holding the insert section, the second catheter comprising at least one retaining portion 22, 24 which is open and closed, to be anchored in the body cavity, by a control section [0031]. The second catheter can maintain the elbow portion in an extended state, see Fig. 12.

Kaloo further discloses a hold section, see Fig. 1 attached to the first catheter 40 to support the catheter unit.

Kaloo discloses the invention as substantially claimed (see above). However, Kaloo does not directly disclose an anchor section which removably anchors the first and second catheters to each other so that the two catheters are assembled in a predetermined position. Valley, in the analogous art, teaches several ways to lock the position of the inner tube with respect to the outer tube C20 L44- C21 L6. This anchor section comprises an adapter 440 (sliding fluid seal) or a locking mechanism 450 comprised of a threaded shaft and a lock nut. The inner tube can be locked in a distal, intermediate or proximal position with respect to the outer tube thus the elbow section of the first catheter can extend distally of the second catheter C21 L7-45. Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified the device of Kaloo with the anchoring connection as taught by Valley for preventing and controlling the axial movement between the first and second catheters.

**7. Claims 4-5 and 9-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kalloo in view of Valley further in view of King (US 5,702,365).**

Kalloo/Valley discloses the invention as substantially claimed (see above). However, this combination fails to disclose the second catheter having an outer sheath and an inner sheath coupled to each other on the distal end with the retaining portion, made of a plurality of slits cut in the outer sheath of the first catheter, opening and closing as the outer sheath is slid relative to the inner sheath. King, in the analogous art, teaches these limitations, see col. 1 lines 30-31 and 41-45, and col. 2 lines 31-38. Therefore it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify the retention balloon of Kalloo/Valley with the inner and outer sheaths axial movement opening and closing the slits of the outer sheath of King for retaining the instrument in a desired location.

**8. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kalloo in view of Valley in view of King further in view of Urick et al. (US 6,676,590) ("Urick").**

The combination of Kalloo/Valley/King above teaches opening a retaining portion of the catheter. In addition, Kalloo discloses inserting an endoscope 40 into the body cavity and further discloses how a variety of diagnostic, therapeutic and/or surgical accessories may be fed through the accessory channel(s) 64 of the endoscope, [0048]. Kalloo/Valley/King fail to disclose the step of setting a tube (with a radiation source) in the conduit of the catheter to be inserted into the living body cavity. Urick, in the

analogous art, teaches the step of setting a tube in the conduit of the catheter, see Fig.

1. Therefore it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify the device of Kalloo/Valley/King with the tube set in the conduit as taught by Urick for administering radiation therapy to a living body. The radiation tube could be inserted through the accessory channel 64 of Kalloo.

### ***Response to Arguments***

9. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DEANNA K. HALL whose telephone number is (571)272-2819. The examiner can normally be reached on M-F 9:00am-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Sirmons can be reached on 571-272-4965. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Deanna K. Hall/  
Examiner, Art Unit 3767  
/Kevin C. Sirmons/  
Supervisory Patent Examiner, Art Unit 3767

Application/Control Number: 10/713,398  
Art Unit: 3767

Page 7